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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,509	06/30/2003	Luis Azcona	60655.1300	8718

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SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, AZ 850040001

EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/611,509	Applicant(s) AZCONA ET AL.	
	Examiner Brian Goddard	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not identify the city and either state or foreign country of residence of each inventor. Namely, the residence is missing for inventor Melinda Pollack. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

Claim Objections

2. Claims 1 and 5 are objected to because of the following informalities: The word 'and' should be inserted before the final limitation in both claims to provide complete sentences. Appropriate correction is required.
3. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 does not further limit claim 1 because the method step recited in claim 2 is non-functional and is given no patentable weight. That a search is "allowed" does not mean that a search is actually performed. Further, a method step with this language ("allowing" something to happen) is indefinite as shown below. Therefore, claim 2 fails to provide any further limitation to claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim language, “allowing” some action to be performed, as recited in each of claims 2, 4 and 5, is indefinite because it is unclear whether or not this step is actually performed. These limitations do not provide active method steps. Further, this language requires intervention by a certain type of skilled user capable of performing the action that is ‘allowed.’ As the scope of this skilled user has not been provided, so too is the scope of the limitation blurred.

In the interest of compact prosecution, the examiner interprets the steps of “allowing” an action to be performed as actually providing some mechanism for performing the action. For example, in claim 2, “allowing a search of the translated text format” is interpreted as ‘providing a search mechanism for searching the translated text format.’

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2161

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent Application Publication No. 2004/0268235 to Wason.

Referring to claim 1, Wason discloses a method for storing binary files in a database as claimed. See Figures 1-10 and the corresponding portions of Wason's specification for this disclosure. Wason teaches "a method [See Fig. 2] for storing binary files [Rich Text files] in a database [4] comprising:

creating a record [See Fig. 2A] in a database [See ¶ 0041];

placing a binary file [Rich Text file (e.g. stored as BLOB)] in a field [100] in said record;

translating [See ¶ 0041] the binary file into a text format [CLOB or Plain Text];
and

placing the translated text format in a different field [101 or 103] in said record" as claimed.

Referring to claim 2, Wason teaches the method of claim 1, as above, further comprising providing a search mechanism [3] for searching the translated text format [See ¶ 0074-0076] as claimed.

Referring to claim 3, Wason teaches the method of claim 1, as above, wherein said translating step comprises: determining the file format of the binary file [See

Abstract and ¶ 0041]; and applying an appropriate algorithm [e.g. Java method to access and convert] to the binary file [See ¶ 0041] as claimed.

Claims 4 and 5 are rejected on substantially the same basis as claims 1-3 above. See the discussions regarding claims 1-3, and the portions of Wason cited therein, for the details of this disclosure.

6. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,729,741 to Liaguno et al.

Referring to claim 1, Liaguno discloses a method for storing binary files in a database as claimed. See Figures 1-6 and the corresponding portions of Liaguno's specification for this disclosure. Liaguno teaches "a method [See Figs. 2-3] for storing binary files [audio and image files] in a database [37 (See Fig. 1)] comprising:

creating a record ['entry'] in a database [See Figs. 1-5];
placing a binary file [original file] in a field [311] in said record [See Figs. 1-3];
translating the binary file into a text format [See Abstract & Fig. 2]; and
placing the translated text format in a different field [301-307] in said record" as claimed.

Referring to claim 2, Liaguno teaches the method of claim 1, as above, further comprising providing a search mechanism [10] for searching the translated text format [See Abstract and all of Figs. 1-6] as claimed.

Referring to claim 3, Liaguno teaches the method of claim 1, as above, wherein said translating step comprises: determining the file format [e.g. text image,

voice/speech (audio) or image] of the binary file; and applying an appropriate algorithm [See 203, 213 and 223] to the binary file as claimed.

Claims 4 and 5 are rejected on substantially the same basis as claims 1-3 above. See the discussions regarding claims 1-3, and the portions of Liaguno cited therein, for the details of this disclosure.

7. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,741,988 to Wakefield et al.

Referring to claim 1, Wakefield discloses a method for storing binary files in a database as claimed. See Figures 3-6 and the corresponding portions of Wakefield's specification for this disclosure. Wakefield teaches "a method [See Figs. 3-5] for storing binary files [e.g. Word, Postscript, Adobe Acrobat] in a database ['searchable database' (See Fig. 6)] comprising:

- creating a record [RTI record] in a database [See Figs. 5-6];
- placing a binary file [original document] in a field in said record [See 'Index Creation'];
- translating the binary file into a text format [See disclosure of 'BOWTIE']; and
- placing the translated text format in a different field in said record [See Figs. 5-6]" as claimed.

Referring to claim 2, Wakefield teaches the method of claim 1, as above, further comprising providing a search mechanism [Database Server] for searching the translated text format [See Fig. 6] as claimed.

Referring to claim 3, Wakefield teaches the method of claim 1, as above, wherein the translating step comprises: determining the file format [e.g. Word, Postscript, Adobe Acrobat] of the binary file; and applying an appropriate algorithm to the binary file [See Column 13, line 14 et seq.] as claimed.

Claims 4 and 5 are rejected on substantially the same basis as claims 1-3 above. See the discussions regarding claims 1-3, and the portions of Wakefield cited therein, for the details of this disclosure.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

U.S. Patent No. 5,884,304 to Davis III et al. is considered particularly pertinent to applicants' claimed invention, while the remaining prior art of record is considered pertinent to applicants' disclosure, and/or portions of applicants' claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 571-272-4020. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg
18 January 2005



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100